REMARKS

I. Introduction

Claims 1-29 are pending in the above application.

Claims 1-29 stand rejected under 35 U.S.C. § 103.

Claims 1, 14, 15 and 27 are independent claims.

II. Rejections Under Prior Art

Claims 1-30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Keith (U.S. Pat. 4,785,349).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Keith does not disclose or suggest improving video quality delivered to a display device by selectively encoding a subsequent video signal if an estimated time to decode an encoded signal exceeds a predetermined decoder time, as substantially required by claims 1, 14, 15 and 27. Keith merely discloses to use a compression threshold "to maintain the average byte count of signal S10 below 4500 bytes per frame." Col. 10: 10-13. When a larger frame is detected, the compression threshold is adjusted to reduce the

decode time of the oversized frame, i.e. to "maintain the average byte count ... below 4500 bytes per frame." Col. 10: 31-32. Keith further discloses that the compression "threshold 238 can be adjusted to merely keep the running average of the decode time below 1/30th of a second." Col. 10: 34-36. Keith is clearly concerned with maintaining an average bytes per frame or an average decode time. Keith does not disclose selectively encoding a subsequent video signal if an estimated time to decode an encoded signal exceeds a predetermined decoder time based on the available processing time of the encoder.

Accordingly, as Keith does not disclose or suggest all of the limitations of any of independent claims 1, 14, 15 or 27, Keith does not render any of these claims unpatentable. Moreover, as claims 2-13 depend on claim 1, claims 16-26 depend on claim 15, and claims 28 and 29 depend on claim 27, Keith also does not render these claims unpatentable.

Applicants further note that the rejection is made under 35 U.S.C. § 103, but it fails to identify a feature which is not taught by Keith, i.e. the rejection fails to determine the "scope and content" of the prior art and ascertain the differences between the prior art and the claims. See MPEP 2141; 2141.02. In the same vein, the rejection further fails to provide any motivation to modify the disclosure of Keith with the missing element to meet all of the claim limitations. See MPEP 2143.01. It is well established that a rejection under 35 U.S.C. 103 must establish each of the above criteria. See MPEP 2142 and 2143. Accordingly, the Office action has not established a prima facie case of obviousness and the rejection is improper on its face.

Hence, Applicant respectfully requests the rejection to be withdrawn.

III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Date: 8/10/05

Respectfully submitted,

By: _____
Lawrence T. Cullen
Reg. No.: 44,489

Motorola Connected Home Solutions
101 Tournament Drive
Horsham, PA 19044
(215) 323-1797